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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/695,517	10/28/2003	James Clement Bishop	01051	5391

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BIOMERIEUX, INC.
PATENT DEPARTMENT
100 RODOLPHE STREET
DURHAM, NC 27712

EXAMINER

LEVKOVICH, NATALIA A

ART UNIT	PAPER NUMBER
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1743

MAIL DATE	DELIVERY MODE
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10/04/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/695,517

Applicant(s)

BISHOP ET AL.

Examiner

Natalia Levkovich

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 July 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) 5-9, 11 and 12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☒ Claim(s) 1-4 and 10 is/are objected to.
- 8) ☒ Claim(s) 1-12 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10/28/2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
- Paper No(s)/Mail Date _____.

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restriction

1. Election of claims 1-4 and 10 (Group I), made without traverse in the reply filed 07/16/2007, is acknowledged.

Drawings

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims, as well as any structural detail that is essential for a proper understanding of the disclosed invention. Therefore, the first and the second positions of the shield, as well as the 'home' and the 'deployment' positions of the cutting element must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Examiner would also like to comment that Applicant provided a lot of excessive drawings not directed to the claimed invention. On the other hand, the only relevant Figures 22-24, while being also overloaded with unnecessary details, do not clearly show important structural cooperation between the claimed elements (see above).

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is

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being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-4 and 10 are rejected under 35 U.S.C. 112, second paragraph, as being unclear for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites an enclosure having an aperture and shield 'moveable between a first position covering said aperture and a second position not covering said aperture'. Since 'covering' usually means 'placing something over

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or upon', it is unclear whether or not the shield is intended to top the aperture disposed in a horizontal plane.

The claim also recites: 'movement of said cutting element assembly through said aperture causes said shield to move to said second position, and wherein movement of said cutting element assembly from said deployed position to said home position causes said shield to move from said second position to said first position covering said aperture'. It is not clear what structural elements would provide for the above-recited functionality. Does Applicant mean some undisclosed controlling or coordinating structure? The same consideration applies to claims 3-4.

Claim 3 recites, in particular, the 'adjustment of the operation of said motor' which appears to require a controlling device.

Claim 3 also recites: 'said motor drives said cutting element assembly relative to said enclosure in a direction having both vertical and horizontal components *relative to said instrument*'. The limitation is indefinite because the orientation of the instrument is not set forth in the claim.

Additionally, claim 4 contains conditional limitations. For example, the claim recites a 'spring-loaded member *adapted* for engagement with said test sample device *when* said cutting element assembly is moved'. Is the spring-loaded member adapted for engagement or not? See also lines 4-8.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this

Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1, 3 and 10 are rejected under 35 U.S.C. 102(b) as anticipated by Krainer et al. (US 5471016).

With respect to claim 1, Krainer discloses a cutting assembly of a shaving apparatus comprising, as shown in Figure1, housing 2 ['enclosure'] having cover 11 ['shield'], the housing accommodating a motor-driven trimmer ['movable cutting element assembly with a cutter (not shown)]. The "shutter – like" cover "is movable between a cover position ['first position'] in which it covers the cutter and an open position ['second position'], in which it exposes the cutter to permit cutting – (see Col.3, lines 58 plus). The trimmer "is movable between a rest ['home'] position, in which it is retracted into the shaving apparatus 1, and an operating ['deployed'] position, in which it is slid out of the shaving apparatus 1" (Col. 3, lines 45 plus).

Regarding claim 3, note that the 'automated sample testing instrument' is not positively recited as a part of the claimed invention. Consequently, it is not accorded any patentable weight.

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The same consideration applies to the 'multi-well test sample card and transfer tube' recited in claim 10.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. Claims 1-4 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Karl et al. (US 5891396) in view of Wirtz-Odenthal (US 5161723).

Karl et al. disclose a cutting and sealing station for test sample cards in an automated analytical system. The cutting station, illustrated in Figures 4-5, includes a hot cutting wire 506 attached to a support plate 504 and connected to a stepper motor drive mechanism 502. The wire assembly is movable between a

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lower position, at the level of transfer tubes 32 {'deployed position'} and an upper ['home'] position – (see Col.7, lines 45 plus).

Although the upper portion of the center mount 34, along with the wall structures of the machine 20 appear to form a kind of a bottom open enclosure, Karl does not specifically teach an enclosure and a shield covering an opening in the enclosure.

Wirtz-Odenthal discloses a foil dispenser "having a housing with an outlet opening adjacent which an electrically heatable wire functions as a foil cutter. The wire normally is covered by a plate-like drop shutter ['shield having two positions' – Ex.] so that the user...will not get his fingers burnt easily by the wire' (Col.1, lines 21-27). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have arranged an enclosure with a shield around the hot wire in the modified apparatus of Karl, in order to protect an operator.


Referring to claim 4, Karl discloses a sample card transport station 700 which includes a drive assembly 702 comprising biasing springs 714 (Figure 17). It appears that, in a similar manner, the drive mechanism 502 connected to the cutting wire 506 via support plate 504 ['spring loaded member'], must also comprise biasing springs. It would have been also within the ordinary skill of an artisan to have employed such springs in the modified apparatus of Karl, in order to provide more reliable connection between the working elements of the sealing and cutting station.

Conclusion

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Natalia Levkovich whose telephone number is 571-272-2462. The examiner can normally be reached on Mon-Fri, 8 a.m.-4p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on 571-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


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